

Procedural Issues Regarding the Restriction Requirements:

Applicants submit for the record that they have preserved their right to petition the propriety of the Restriction Requirement of May 22, 2001 and subsequent withdrawal from consideration of previously elected claims. The Examiner acknowledged Applicants' June 22, 2001 election of "Embodiment 5 of Figures 8A and 8B" (Office Action of September 13, 2001, p. 2) and treated this election as one made without traverse. Applicants point out for the record that they elected claims 1 – 11 and 14 – 20 as readable on Embodiment 5 in their Response of June 22, 2001. The Examiner then withdrew claims 1 – 9, 11 – 13, 16 – 18, and 20 *sua sponte* (Office Action of September 13, 2001, p. 2), and alleged that *this* election was made without traverse. This is wholly untrue. The only election that could be considered without traverse was Applicants' election of claims 1 – 11 and 14 – 20, *not* the Examiner's choice to only examine claims 10, 14, 15, and 19 (despite Applicants' election of additional claims), as Applicants were never afforded the courtesy of a full consideration of, and reply to, their traversal of the Examiner's multiple restrictions.

Furthermore, the Examiner has successively pared down the claims under examination to the point that now only claim 19 is being examined on the merits, after Applicants' insistence that claim 19 was readable on elected Embodiment 5. In response to Applicants' arguments that claim 19 was readable on elected Embodiment 5, the Examiner withdrew claims 1 – 10, 15, 17, 18, and 20 – 30 from consideration on September 24, 2002.

Applicants respectfully submit that the Examiner's decisions to restrict Applicants' claims are excessive, unnecessary, unfounded, and most importantly – costly (in time and money). The advancement of prosecution of the present application has been impeded by the

(...continued)

19 for examination on the merits in the previous Office Action of September 24, 2002.

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constant switching of which claims are under examination. Applicants respectfully point out that “[t]he Examiner should clearly set forth the reasons why the claims withdrawn from consideration are not readable on the elected invention.” M.P.E.P. § 821, 8th Ed., Rev. 1 (Feb. 2003), p. 800-61. Since May 22, 2001, the Examiner still has not complied with this requirement. The Examiner also has not met the requirement that “[t]here must be a serious burden on the examiner if restriction is required.” M.P.E.P. § 803.01, p. 800-4. Therefore, Applicants note on the record that they still preserve the right to Petition these improper Restriction Requirements should the Examiner refuse to reconsider and examine the claims elected by Applicants after this Request.

Procedural Issues Regarding Applicants’ IDS filed on May 18, 2000:

When Applicants’ May 18, 2000 IDS was filed, co-pending applications were not listed on the corresponding form PTO-1449. Nevertheless, the Examiner is still obligated to consider such documents and to indicate as much by appropriate notation in the text of the IDS document, where co-pending applications were cited. Noting these requirements, Applicants still have not received an initialed copy of the May 18, 2000 IDS, to indicate the Examiner’s consideration of the cited co-pending application no. 09/369,174. For the Examiner’s convenience, Applicants attach herewith a copy of the IDS filed on May 18, 2000, citing the co-pending application in the text of the IDS on page 1. Applicants request that the Examiner acknowledge consideration of the listed co-pending application by initialing the margin of the IDS next to the reference to the co-pending application, and request a copy be returned to Applicants with the next communication from the Office. Alternatively, Applicants would be willing to list the co-pending application on a supplemental IDS and Form PTO 1449, should the Examiner request this directly from Applicants’ undersigned representative.

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Regarding the rejection of claim 19 under 35 U.S.C. § 112, 1st ¶:

The Examiner rejected claim 19 under 35 U.S.C. § 112, 1st paragraph, as allegedly “containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention” (Final Office Action, p. 2).

Regarding the rejection of claim 19 under 35 U.S.C. § 112, 1st paragraph, Applicants respectfully dispute the Examiner’s allegations made on p. 2 of the Final Office Action. Contrary to the Examiner’s allegations, Applicants’ specification does describe all claimed subject matter in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner alleged “[t]he limitation (a lower electrode having a side and upper surface, wherein a surface area of the side being larger than a surface area of the upper surface) is not supported by the original specification and/or drawings” (Final Office Action, p. 2, emphasis in original). Applicants again dispute this allegation, noting that the contents of the recitation are disclosed in the specification from p. 27, l. 20 to p. 28, l. 4 of Embodiment 1. Since the elected Embodiment 5 is based on Embodiment 1, the recitation is completely supported by the original specification.

In light of the above-mentioned exemplary description of an embodiment of the invention contained in the specification, Applicants therefore submit that the Examiner *still has not met* his “initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” M.P.E.P. § 2163.04, pp. 2100-173.

Finally, Applicants submit that, for the reasons already presented above, all subject matter in “the specification conveys with a reasonable clarity to those skilled in the art that, as of

the filing date sought, applicant[s] [were] in possession of the invention as now claimed.”

M.P.E.P. § 2163, p. 2100-158. Claim 19 fully complies with the requirements of 35 U.S.C.

§ 112, 1st paragraph, and Applicants again request withdrawal of the rejection.

Regarding the rejection of claim 19 under 35 U.S.C. § 102(b):

Applicants respectfully traverse the rejection of claim 19 under 35 U.S.C. § 102(b) as anticipated by Kashihara.

In order to properly establish that Kashihara anticipates Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference.

Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, p. 2100-70, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Regarding the 35 U.S.C. § 102(b) rejection, Kashihara does not teach each and every element of Applicants’ present invention as claimed.

Applicants’ independent claim 19 recites a combination of elements, among them: “a lower electrode formed in contact with the conductive plug and having a side and upper surface, a surface area of the side being larger than a surface area of the upper surface.”

Kashihara is clearly different from Applicants’ independent claim 19. Unlike Applicants’ claimed invention, Kashihara does not disclose at least these elements of Applicant’s claim 19.

In contrast, Kashihara teaches a lower electrode layer 1 formed in contact with a barrier metal layer 13 on plug layer 43a. See Kashihara’s Figure 1. Kashihara does not disclose anything

about the lower electrode having a side and upper surface, ***a surface area of the side being larger than a surface area of the upper surface***. Further, Kashihara teaches a capacitor

insulating layer 3 formed on lower electrode layer 1. Kashihara does not disclose anything about

the capacitor insulating layer 3 being formed above a top surface of the lower electrode layer 1 *via a* second insulating film different from the capacitor insulating film. Thus, Kashihara does not disclose each and every element of Applicants' claim 19.

It appears that Applicants' previous arguments have been dismissed concerning this point, by both omitting an analysis that includes the full recitation of the elements of Applicants' claim 19, and by alleging that Applicants' previous arguments were "not convincing because the limitation (a surface area being larger than a surface area of the upper surface) is not support [ed] by the specification and/or drawings" (Final Office Action, p. 3). Applicants note that the Examiner must consider all the elements of Applicants' claimed invention, in as complete detail as contained in the claim, and also must consider all elements even when contesting support in Applicants' specification. Applicants have also already established herein that the elements of Applicants' claimed invention do have full support in the specification and drawings, and furthermore have support in the presently elected embodiment. Applicants respectfully remind the Examiner that the M.P.E.P. establishes that "when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. [citations omitted]." M.P.E.P. § 2106, p. 2100-9. "Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum." Id. at 2100-8.

As Applicants have demonstrated herein, since Kashihara does not disclose each and every element of Applicants' independent claim 19, Kashihara does not anticipate Applicants' claimed invention. Applicants submit that the Examiner has not met the essential requirements of anticipation for a 35 U.S.C. § 102(b) rejection. Therefore, the rejection is improper and should be withdrawn.

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Moreover, regarding the Examiner's allegation that Kashihara's "capacitor insulating layer (11d) being formed above a top surface of lower electrode (1) via a second insulating film (3) ... different from the capacitor insulating film..." (Final Office Action, p. 3), it appears that the Examiner alleged certain features are inherent in Kashihara because two different insulating films in Kashihara are composed of different materials. Regardless of whether the two films are composed of different materials, Applicants' note that this is still not one film formed *via* another, and therefore not anticipatory of Applicants' claimed "the capacitor insulating film being formed above a top surface of the lower electrode via a second insulating film different from the capacitor insulating film" (claim 19). Applicants respectfully remind the Examiner that:

"[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. *Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that is would be so recognized by persons of ordinary skill.*"

M.P.E.P. § 2131.01(III), p. 2100-71 (italics added for emphasis), quoting *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). *See also* M.P.E.P. § 2112, pp. 2100-51 – 2100-52.

Applicants submit that the Examiner has not supplied the requisite extrinsic evidence, let alone any evidence in Kashihara, that makes clear that "the capacitor insulating film being formed above a top surface of the lower electrode via a second insulating film" is necessarily present in Kashihara. In addition, Applicants note that "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient" M.P.E.P. § 2112, p. 2100-52 (internal citations

omitted). The Examiner has not established that any of Applicants' claimed features are explicitly taught by Kashihara or, as a secondary consideration, that they are inherent in Kashihara, and has not presented any factual basis or technical reasoning to demonstrate as much. It is therefore improper for the Examiner to infer that Applicants' claimed features, quoted above, necessarily flow from Kashihara.

Since Kashihara does not disclose each and every element of Applicants' present invention, Kashihara does not anticipate independent claim 19. Therefore, Applicants respectfully submit that claim 19 is patentable over Kashihara.

Regarding dependent claim 20: "Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were present as one independent claim." M.P.E.P. § 608.01(n)(III), p. 600-77.

Therefore, since Applicants have shown above that independent claim 19 is allowable, Applicants submit that dependent claim 20 is also allowable at least by virtue of their dependence from allowable base claim 19.

Thus, since Kashihara does not disclose each and every element of Applicants' independent claim 19, Kashihara does not anticipate Applicants' claimed invention. In addition to Kashihara not anticipating the present invention, Kashihara does not disclose an identical invention, let alone in as complete detail as contained in Applicants' independent claim 19. Accordingly, Applicants submit that the Examiner has not met these essential requirements of anticipation for a proper 35 U.S.C. § 102(b) rejection.

Conclusion:

In making various references to the specification and drawings set forth herein, it is understood that Applicants are in no way intending to limit the scope of the claims to the

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exemplary embodiments described in the specification and illustrated in the drawings. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law. Applicants respectfully point out to the Examiner that "[e]ach claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description." M.P.E.P. § 2163(II)(A)(1), p. 2100-163.

In view of the foregoing remarks, Applicants request the Examiner's reconsideration of the application and submit that the rejections detailed above should be withdrawn. For the reasons articulated herein, Applicants submit that independent claim 19 is allowable, for the reasons already argued above. In addition, dependent claim 20 is also allowable at least by virtue of its dependence from allowable base claim 19. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Applicants again encourage the Examiner to reconsider the multiple, unnecessary, and costly restrictions he has placed on Applicants' claims, and Applicants' undersigned representative would welcome the opportunity to discuss this with the Examiner prior to filing a Petition.

Regarding the claims, should the Examiner continue to dispute the patentability of the claims after consideration of this Request, Applicants encourage the Examiner to contact Applicants' undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time under 37 C.F.R. § 1.136 required in entering this response. If there are any fees due under 37 C.F.R. § 1.16 or 1.17, which are not enclosed,

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including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 11, 2003

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